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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>TR104546P00161US</b>	
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		First Named Inventor  <b>Joseph M. Koenig, Jr.</b>	
		Art Unit  <b>3727</b>	Examiner  <b>Maurina T. Rachuba</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	Signature	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Jeffery N. Fairchild	
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number <b>37,825</b>	(312) 876-2106	
		Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	July 17, 2012	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/>	*Total of <u>2</u> forms are submitted.		

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## **STATEMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

This is a request for review of the rejection made in the April 17, 2012 Final Office Action in the above case. A review is requested with respect to the errors specifically identified below.

### **THE REJECTION OF CLAIMS**

Claims 1-9 and 13 are pending and at issue. Claims 1-9 stand rejected as unpatentable over Applicant's admitted prior art (AAPA) in view of Kingman (US 2,386,900), and claim 13 stands rejected as unpatentable over AAPA in view of Kingman and in further in view of Hays (US 2,553,254).

### **CLEAR ERROR**

The rejection of claims 1-9 as unpatentable over Applicant's admitted prior art (AAPA) in view of Kingman 2,386,900 is improper because it is based upon a clearly improper modification of Applicant's disclosed prior art sanding block by Kingman, and, independent of the improper modification, the references relied on in the rejections fail to disclose or suggest all of the structure recited in the claims.

### **REMARKS**

Applicant's disclosed prior art sanding (AAPA) block is for drywall finishing whereas Kingman is directed toward a scourer for kitchen utensils. One skilled in the art of drywall finishing would not look to the kitchen utensil teachings of Kingman while seeking to modify drywall sanding blocks. In response to this argument, the Examiner asserts that the reliance on Kingman is proper because it is in the field of Applicant's endeavor, which the Examiner broadly characterized as "abrasive tools". However, there is absolutely nothing to support such a broad characterization of Applicant's field of endeavor other than a hindsight desire to use Kingman in rejecting the claims. The

Examiner could have just as easily, and just as inaccurately, asserted that the field of endeavor was to handheld tools if that was what was required in order to bring in other irrelevant art in order to reject the claims. In this regard, it cannot be ignored that the title of the application is "Sanding Block", all of the claims are expressly directed to a "sanding block", and the field of the invention states that the application is directed towards "sanding blocks". Accordingly, the reliance on Kingman is improper.

Further in this regard, the problem addressed by Kingman, the vast diversity of shapes and sizes encountered in kitchen utensils or cookware, does not speak to the drywall sanding task associated with the drywall sanding block of the **AAPA**. In response to this argument, the Examiner asserts that Applicant's disclosed invention and Kingman "are both concerned with preventing damage to the workpiece being treated". However, contrary to this assertion, there is nothing in the disclosure of Kingman to indicate a concern "with preventing damage to the workpiece being treated". Rather, Kingman is expressly directed to achieving "an efficient scraping and scouring action so as to "quickly loosen and scrape away encrusted and caked dirt, grease and soil" (see column 2, lines 54-57). Furthermore, there is absolutely nothing in Kingman to indicate that its device would be suitable or advantageous in "preventing damage to the workpiece being treated" in a drywall sanding block such as is disclosed in the **AAPA**. Accordingly, the Examiner's naked, unsupported assertion regarding Kingman does nothing to overcome the clear error of the rejection.

Furthermore, even if one skilled in the art of drywall finishing were to look to kitchen utensil teachings, and specifically to Kingman, one so skilled would not see the teachings of Kingman's rigid core scouring device as being relevant or useful to the "flexible, compressible, polymeric foam" core sanding block of the **AAPA**. In this regard, the four different edge profiles of Kingman's scouring device are necessary because the rigid core of Kingman cannot conform to the diversity of shapes and curvatures presented by the variety of kitchen utensils and cookware that may require scouring in any given kitchen. This problem is not encountered with the **AAPA** device because its "flexible, compressible, polymeric foam" core can allow the sanding block to conform to any curved surface without requiring that the edge profile of the sanding block be closely matched to

the curved surface being sanded. Thus, Kingman's teaching does not suggest a benefit to the **AAPA** device. As enunciated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, (82 USPQ2d at 1396) there must be some articulated reason with some rational underpinning to support the legal conclusion of obviousness. There can be no rational underpinning for modifying a reference with no apparent benefit, such as is done in the proposed modification. Accordingly, for this additional reason, the rejection is improper and should be withdrawn.

In response to the foregoing argument, the Examiner previously asserted that Kingman is relied upon to teach that edges of an abrasive block may be curved, **and not the core** which is taught by **AAPA**. However, in making a proper rejection under §103, the Examiner cannot simply ignore the parts of the prior art that are inconvenient and inconsistent with the modification the Examiner is attempting to propose. See MPEP §2142.02 VI stating that "a prior art reference must be considered in its entirety, i.e., as whole, including portions that would lead away from the claimed invention". In short, under the case law and the rules set forth in the MPEP, Kingman must be considered as a whole and the assertion that the Examiner is not relying on Kingman's core further illustrates clear error on the Examiner's part in ignoring the whole of the disclosure of Kingman. For this additional reason, the rejection is improper and should be withdrawn.

Additionally, the Examiner has previously referenced Applicant's own disclosure of Applicant's invention (not the **AAPA** device) in attempting to support the rejection by stating that:

Here, Applicant has disclosed that the curved edge prevents damage to the workpiece, while allowing the workpiece to be abraded. Similarly, Kingman teaches that a curved edge prevents damage to the workpiece, in that the curved edge removes unwanted material from the workpiece, while allowing the workpiece to be abraded.

The Examiner's express reliance on Applicant's disclosure of his invention in support of the rejection is yet another illustration of clear error in making the rejection and further evidences the hindsight reconstruction of Applicant's claimed structure using Applicant's specification as a template. It is axiomatic that Applicant's disclosure of his own

invention cannot be used as prior art in supporting rejection. For this additional reason, the rejection is improper and should be withdrawn.

Additionally, claims 1 and 13 characterize both expansive sides as being abrasive, with each expansive side having a sharp edge and a curved edge. This structure is neither shown nor suggested by the **AAPA**, Kingman, or Hayes (relied on in the rejection of claim 13), taken alone or together. Indeed, quite the opposite, the **AAPA** device and Hayes both teach that all four edges of the expansive side should have the same profile and Kingman teaches that all four edges of the device should have different profiles. Thus, none of the references show or suggest a sanding block wherein two of four edges are sharp and the other two of the four edges are curved. Furthermore, in this regard, Kingman expressly teaches away from the claimed structure by expressly requiring that each of its edges have a different profile so as to allow the rigid core scourer to better conform to the diversity of curved shapes that would be encountered in the kitchen utensils and cookware of a typical kitchen. Again, the teachings of Kingman cannot be ignored in this regard. See again MPEP §2142 VI and further see MPEP §2145 (X)(D)(2.) stating that "references cannot be combined where references teach away from their combination" and further that "it is improper to combine references where the references teach away from their combination". Again, it is clear error to attempt the rejection completely contrary to the rules set forth in the MPEP and the case law. The shortcomings of the rejection in this regard are highlighted by the Examiner's failure to acknowledge or address the above argument in any way, despite having multiple opportunities to do so. Accordingly, for this additional reason, the rejection of claims 1-9 should be withdrawn and the claims allowed.

Furthermore, claims 2 and 13 further distinguish the references by characterizing the radius of one curved edge as being substantially equal to the radius of the other curved edge. Again, this structure is neither shown nor suggested in the applied references and is particularly taught away from by the teachings of Kingman which requires its four edges to each have a different profile from any of the other edges. See again MPEP §2142 VI and further see MPEP §2145 (X)(D)(2.) stating that "references cannot be combined where references teach away from their combination" and further

that "it is improper to combine references where the references teach away from their combination". Again, it is clear error to attempt a rejection completely contrary to the rules set forth in the MPEP and the case law. The shortcomings of the rejection in this regard are highlighted by the Examiner's failure to acknowledge or address the above argument in any way, despite having multiple opportunities to do so. Accordingly, for this additional reason, the rejection of claims 2 and 13 should be withdrawn.

Additionally, in rejecting claim 13, the Examiner implicitly acknowledges that the proposed combination of **AAPA** and Kingman fails to disclose "the radius of one curved edge being substantially equal to the radius of the other curved edge" as recited in claim 13 because the rejection seeks to overcome the failings of the **AAPA** and Kingman by relying on Hayes 2,553,254. However, claim 2 recites this same structure, yet the Examiner attempts to reject claim 2 only on the basis of the **AAPA** and Kingman. For this additional reason, there is a clear error in the rejection of claim 2 and the rejection of claim 2 should be withdrawn.

### **CONCLUSION**

It is respectfully requested that the Panel review the Examiner's April 17, 2012 Final rejection, particularly based upon the errors noted above, and that the Examiner's rejection of all pending claims be reversed.